

REMARKS

Claims 40 and 41 are pending in the Application. Claims 40 and 41 have been amended. Claims 1-38 and 42 are herein cancelled without prejudice and without disclaimer of subject matter. Applicants are not conceding in this Application that those claims are not patentable over the art cited by the Examiner, as the present claim amendments and cancellations are only for facilitating expeditious prosecution of the remaining subject matter. Applicants respectfully reserve the right to pursue these and other claims in one or more continuations and/or divisional patent applications.

Applicant thanks the Examiner for the indications on Page 2 of the Office Action that Applicant's previously submitted amendments to the specification, Claims 3, 7, 20-38, and 41 overcome the respective objections and §112 rejections.

On page 4 of the Office Action, Claim 41 is rejected under 35 U.S.C. §101 as being directed toward non-statutory subject matter. Claim 41 has been amended to recite "[a] computer program comprising a computer readable storage medium having a computer readable program..." which is believed to overcome the rejection under 35 U.S.C. §101. Applicant also points out that the storage of a pseudo name and designated time frame are tangible results which meet the requirements of 35 U.S.C. §101.

On Page 5 of the Office Action, Claims 1-3, 5-7, 9-10, 13-14, 18-22, 24-26, 28-29, 32-33 and 37-41 are rejected under 35 U.S.C. §103(a) as being unpatentable over Lee, et al., U.S. Pat. Pub. No. 2002/0029152 in view of Deans, et al., 2003/0208364. As an initial matter, Claims 1-3,

5-7, 9-10, 13-14, 18-22, 24-26, 28-29, 32-33 and 37-39 have been cancelled, thereby rendering the rejections of these claims moot.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, which would prompt one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Independent Claim 40, as amended, recites a system for routing a mail object including in part, “means for registering a pseudo name and *providing instructions for one or more mail services* in a user profile associated with the pseudo name,” (emphasis added). Claim 41, as amended, recites a computer program that causes the computer to “store a psuedo name to be displayed on the mail object and a user profile associated with the pseudo name, *the user profile providing instructions for one or more mail services*,” (emphasis added). Lee fails to disclose any user profile associated with a pseudo name, let alone a user profile “providing instructions for one or more mail services” as stated in Applicant’s Claims 40 and 41.

As discussed in Applicant’s previous response, Lee discloses a method and apparatus for tracking mail items. In particular, Lee discloses a method generally including the steps of, “inducting the mail item into the carrier distribution system, the mail item having thereon a unique sender generated identifier...assigning a unique carrier generated identifier to the mail item; associating the unique sender generated identifier with the unique carrier generated

identifier...and allowing the sender to obtain location information about the mail item using the unique sender generated identifier,” (¶[0007]). In other words, Lee discloses correlating a sender ID with a carrier ID for tracking purposes. That’s it. This correlation cannot be described as a user profile providing instructions for one or more mail services, as in Claims 40 and 41. There is nothing in Lee that would prompt one of ordinary skill in the art to look to elsewhere, whether to Deans or any other reference, for a way to provide instructions for mail services based on a user profile.

In addition, the method for tracking in Lee is triggered by the inclusion of an “EAIM” on the package itself, e.g., “when a premium mail item 1 which requires electronic confirmation and/or track and trace service is sent to the AFC 23 (step 42), the AFC 23...determines that the mail item 1 requires such special processing *by detecting the EAIM 13* on the face of the mail item 1 (step 43),” (¶[0020])(emphasis added). Once the “EAIM” is detected on the package, the tracking system is used to provide tracking information to the sender. Lee fails to disclose any ability of the sender to provide instructions or preferences for one or more mail services, and in fact, the sender / EAIM generator has no ability to affect the actual handling of the package whatsoever. The single component of mail delivery disclosed by Lee is a tracking service for “premium mail items,” which is simply triggered by the inclusion of a particular EAIM on a package to be delivered, and fails to include any involvement or correlation of preferences, instructions or the like that could be characterized as a “user profile” associated with a particular sender or pseudo name.

Pages 9 and 10 of the Office Action point to ¶[0006], ¶[0007] and ¶[0034] of the Lee reference as disclosing aspects of Applicant's claimed pseudo name and user profile elements. However, these cited portions of the Lee reference, and indeed the reference in its entirety, fail to disclose Applicant's claimed invention. These cited paragraphs clearly disclose correlating a sender ID to a carrier ID in a database for tracking purposes, which as described above, cannot be characterized as disclosing the above-recited features of Applicant's Claims 40 or 41, as amended.

Independent Claims 40 and 41 further recite, in part, "providing instructions for one or more mail services in a user profile associated with the pseudo name, the user profile having *a designated time frame for which the user profile is active*," (emphasis added) and "a user profile associated with the pseudo name, the user profile providing instructions for one or more mail services...*store a designated time frame for which the user profile is active*," (emphasis added), respectively. The Examiner recognizes that Lee fails to disclose any such designated time frames associated with a user profile, and further cites to Deans as disclosing the time frame and that it would have been obvious to modify Lee in view of Deans "in order to enhance the security of the profile," citing to ¶[0037] of Deans (Office Action, Page 10). Primarily, as discussed above, Lee completely fails to disclose a user profile associated with a pseudo name. Further, even if Lee could be improperly characterized as disclosing a user profile and pseudo name as claimed by Applicant, modification of Lee in view of Deans is improper and still fails to disclose Applicant's Claims 40 or 41.

There is simply no motivation or prompting in these references that would lead one of ordinary skill to want to combine the Lee and Deans references. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. As noted above, this prompting is absent from the cited references.

As an additional example, Lee discloses a mail tracking system “that allows senders of a mail item to obtain track and trace and/or confirmation of delivery services without interfacing with the carrier service prior to submission of the mail item into the carrier distribution system,” ¶[0005]. Deans, on the other hand, discloses using an “Indirect Address Code (IAC)” instead of an actual address to protect the privacy of someone’s physical location (See ¶[0037]). There is no suggestion of any desirability in either of the references as to why a system for tracking mail as disclosed in Lee would be modified to include features of a privacy-based mail method of retaining anonymity with a physical location of delivery. In addition, there is no apparent reason why a person skilled in the art would combine the teachings of the cited references. Simply stated, there is no motivation, suggestion, or desirability either in the references themselves or in the general knowledge of the field as to why a person of skill in the art would place a time limit on the ability to track a package, contrary to the Examiner’s assertion of “enhanced security.” Claims 40 and 41 are patentable for at least this reason.

Even if the references were properly combinable, the combination still fails to disclose what is claimed by Applicant. In particular, Deans teaches that “the IAC 102 expires

automatically after some number of uses or a certain period of time,” (§[0037]), where Deans explicitly defines the IAC as “a unique set of characters that can be evaluated into a fully specified deliverable address only through the use of a reference table,” (§[0024]). The IAC of Deans is clearly not a user profile having instructions for one or more mail services as claimed by Applicant, and as such, any temporal characteristic of the IAC of Deans is irrelevant to Applicant’s claimed “designated time frame for which the user profile is active,” as recited in amended Claims 40 and 41.

Accordingly, Lee and Deans, whether considered alone or in combination, clearly fail to disclose “means for registering a pseudo name and providing instructions for one or more mail services in a user profile associated with the pseudo name; the user profile having a designated time frame for which the user profile is active,” or the ability to “store a psuedo name to be displayed on the mail object and a user profile associated with the pseudo name, the user profile providing instructions for one or more mail services... [and] a designated time frame for which the user profile is active,” as recited in Applicant’s amended Claims 40 and 41, respectively. As such, the rejections of the amended claims are unsupported by the art, and withdrawal of the rejections of these claims is respectfully requested.

On Page 11 of the Office Action, Claims 4, 8, 12, 15-17, 23, 27, 31 and 34-36 are rejected under 35 U.S.C. §103(a) as being unpatentable over Lee, et al., in view of Deans, et al., and further in view of Lorch, et al., Intl. Pub. No. WO 02/51051. Claims 4, 8, 12, 15-17, 23, 27, 31 and 34-36 have been cancelled, thereby rendering the rejection of these claims moot.

On Page 15 of the Office Action, Claims 11 and 30 are rejected under 35 U.S.C. §103(a) as being unpatentable over Lee, et al., in view of Deans, et al., and further in view of Official Notice. Claims 11 and 30 have been cancelled, thereby rendering the rejection of these claims moot.

For all of the above reasons, the claim objections are believed to have been overcome placing Claims 40 and 41 in condition for allowance, and reconsideration and allowance thereof are respectfully requested.

The Examiner is encouraged to telephone the undersigned to discuss any matter that would expedite allowance of the present application.

The Commissioner is hereby authorized to credit overpayments or charge payment of any additional fees associated with this communication to Deposit Account No. 090457.

Respectfully submitted,

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